

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 26, 27, 29, and 30 are requested to be cancelled without prejudice.

Claims 1, 16, and 28 are currently being amended.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claims remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1-25 and 28 are now pending in this application.

In Section 2 of the Office Action the Examiner rejected claims 1-6, 13, and 26-30 under 35 U.S.C. §103(a) as being unpatentable over Lebby et al. (U.S. Patent No. 6,115,618) in view of Branson (U.S. Published Application No. 2003/0071832 A1). With regard to claim 1 and likewise claim 28-30, the Examiner states that Lebby et al. does not disclose that the display system can be expanded from an initial or storage state to present a larger visual display, however, Lebby et al. teaches that a display may be detached from a portable electronic device. The Examiner further states that Branson discloses a flexible and foldable display type for a portable device. Further still, the Examiner states that “one would have been motivated to make such a change based on the teachings of Branson that foldable, flexible displays have been developed, offering a small size for portability and a larger display screen size for use.” To this assertion by the Examiner, the applicants disagree. The mere fact that references can be combined or modified does not render the resultant in combination obvious unless the prior art also suggests the desirability of the combination. In Re Mills, 916 F.2d 680, 16 U.S.P.Q. 2d 1430 (Fed. Cir. 1990). What the Examiner provides for motivation, is that Branson teaches that the foldable flexible displays have been developed offering small size for portability and a larger display screen size for use. This teaching of Branson does not provide any desirability or motivation to have the display screen detachable from the base handheld unit. Further, the

teaching of detachability found in Lebby does not provide a desirability for making the screen changeable in size through foldability and flexibility. There is no desire annunciated in Lebby et al. to display more information on the display screen and there is no desirability annunciated in Branson to provide detachability of a display screen. Accordingly, there is no *prima facia* case of obviousness provided because there is no motivation to combine the references of Lebby et al. and Branson. Accordingly, independent claims 1 and 28, as amended, are allowable. Further, claims depending from independent claims 1, and 28 are also allowable.

In Section 12 of the Office Action, the Examiner has rejected independent claims 1 and 16 as being unpatentable over Oliwa et al. (U.S. Patent No. 4,856,088) in view of Branson (U.S. Published Application No. 2003/0071832 A1). Applicants respectfully submit that with regard to independent claim 16, independent claim 16 has been amended to include the limitation that “a second communication port coupled to the visual display and communicating with the first communications port when the visual display unit is detached from the handheld computing device.” Accordingly, neither Oliwa et al. nor Branson provides the limitation that the second communications port communicates with the first communications port when detached. The display of Oliwa et al. is strictly used as a display for information that has been stored in the display module memory and is not an active communication link between the base unit and the display module. Accordingly, claims 1 and 16, as amended are therefore not obvious in view of Oliwa et al. and Branson. The arguments provided above with regards to the rejection under Lebby et al. and Branson also apply to the amended claims 1 and 16. Accordingly, applicants respectfully submit that independent claims 1 and 16 and their respective dependent claims are therefore allowable.

Double Patenting

In Section 27 of the Office Action, the Examiner indicated that a number of the claims are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of co-pending applications. Applicants reserve the right to file a Terminal Disclaimer in this case should the claims be found allowable, as currently requested. No Terminal Disclaimer is being filed with this amendment.

Applicants believe that the present application is now in condition for allowance.
Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date June 28, 2004

By Alistair K. Chan

FOLEY & LARDNER LLP
Customer Number: 26371
Telephone: (414) 297-5730
Facsimile: (414) 297-4900

Alistair K. Chan
Attorney for Applicants
Registration No. 44,603